

Appl. No. 10/676,662
Response dated September 18, 2007
Reply to Office Action dated August 13, 2007

REMARKS

Claims 1, 4, 7-9, 11, 14, 15, 17-19, 21, and 24-34 are currently pending in this continuation application. After Applicants filed an Appeal Brief on April 12, 2007, the Examiner reopened prosecution on this application, and mailed a Non-Final Office Action on August 13, 2007. Reconsideration of the claims of this continuation application in view of the following remarks is respectfully requested.

A. Rejection Of Claims 1, 4, 7, 9, 11, 14, 15, 18, 19, 21, 24, 25, 27-29, 31, and 34 Under 35 U.S.C. § 103(a)

Claims 1, 4, 7, 9, 11, 14, 15, 18, 19, 21, 24, 25, 27-29, 31, and 34 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,846,262 issued December 8, 1998 to Sayama et al. ("Sayama") in view of U.S. Statutory Invention Registration No. H1674 published August 5, 1997 to Ames et al. ("Ames"). Applicants traverse the rejection. Applicants assert that the combination does not include each and every element of the invention as presently claimed. Importantly, Applicants respectfully assert that the Examiner has again failed to give proper weight to the exclusionary phrase "consisting essentially of" in evaluating the claims.

The pending application has three independent claims: claims 1, 9, and 19. Each of the claims includes "attachment panels" that "consist essentially of an elastomeric nonwoven material" and that define "inner attachment surfaces." The separately attached fastening components of the claimed embodiments (e.g., the hook-type components) are disposed on the outer surface of the garment, and engage the inner attachment surfaces defined by the side panels. In this way, the engaging elements which project from the surface of mechanical fastening elements are less likely to irritate or "poke" the wearer. See, e.g., "Summary of the Invention" at page 2, lines 15-19 ("The use of the side attachment panels to engage the fastening component reduces the chance for skin irritation because potentially irritating fastener components, such as hook fasteners, are disposed on the exterior surface of one waist region and covered by the side attachment panels.")

In the Office Action, the Examiner states: "The inner attachment surface is not specifically claimed or precisely defined in the specification. Therefore, it can be broadly read into any attachment surface including the surface with the fastener." Office Action, page 2. Applicants respectfully assert that these statements are in error. The phrase "inner attachment surfaces" is positively recited in each independent claim, and is clearly defined in the specification. See Specification, page 18, lines 30-33

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("The engaging elements of these fastening components 84 and 85 are adapted to repeatedly engage and disengage the inner surfaces 28 of the attachment panels, which surfaces are also referred to as inner attachment surfaces.")

But more importantly, in the embodiments of the invention presently claimed, it is not just any attachment panels that define the "inner attachment surfaces." Each of the currently pending independent claims (claims 1, 9, and 19) requires that each attachment panel consist essentially of an elastomeric nonwoven material, and each of which defines an inner attachment surface. It is widely accepted that the transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. MPEP 2111.03. Applicants have clearly indicated in the specification what the basic and novel characteristics of the presently claimed invention are with respect to this claim phrase: "In particular embodiments, the attachment panels consist essentially of the elastomeric nonwoven materials *such that no separate fastening materials or fastening elements, loop material for example, are formed from or attached to the attachment panels.*" Specification, page 3, lines 18-21. When the applicant *explicitly states* the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art. *In re Zletz*, 13 USPQ 2d 1320, 1322 (Fed. Cir. 1989) (emphasis added). MPEP section 2173.05(a) likewise states: *When the specification states the meaning that a term in the claim is intended to have, the claim is examined using that meaning...* (emphasis added; citations omitted).

Therefore, the "inner attachment surface" *cannot* be "broadly read into any attachment surface including the surface with the fastener" as suggested by the Examiner. Instead, the "inner attachment surface" of the attachment panels of the presently claimed embodiments have no separate fastening materials or fastening elements.

Sayama discloses a diaper 1 provided with front wings 11 and rear wings 12. Col. 2, lines 4-7. The diaper is provided with a hooked fastener component 15 bonded to the inner surface of each rear wing, which interlocks with a looped fastener component 16 bonded to the outer surface of the front waist region and wing 6, 11. Col. 2, lines 19-42. Since each wing of the Sayama diaper has a separate fastener element attached thereto, none of the wings can "consist essentially of an elastomeric nonwoven material." Consequently, Applicants' invention as presently claimed is patentable over Sayama/Ames.

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The Examiner states that "Sayama, the reference teaches a non-irritating fastener outer layer." Office Action, page 2. The only non-irritating feature called out in Sayama is that the separately attached hook fastener, which is bonded to the inner layers of the side panels, is covered with a protective sheet to alleviate skin irritation. Thus, the hook fastener of Sayama falls short of Applicants' claimed invention, both because it is separately attached and because it resides on the inner surface, not the outer surface.

Dependent claims 7, 14, and 24 are patentable over Sayama/Ames for an additional reason. Claims 7 and 24 further recite that "the first and second waist regions are not refastenably connectable other than by the refastenable connection of the mechanical fastening elements and the inner attachment surfaces." Similarly, claim 14 recites that "the front and back waist regions are not refastenably connectable other than by the refastenable connection of the plurality of engaging elements and the inner attachment surfaces." In referring to Sayama/Ames, the Examiner states that "[t]he first and second waist regions are connectable only by the engagement of an inner attachment surface 15 and fastening components 16." Office Action, page 5.

Neither Sayama nor Ames, nor the two in combination, offers or suggests the claimed feature. As discussed above, the front and rear regions of the diaper of Sayama are connected by interlocking hook fasteners bonded to the rear wings to loop fasteners bonded to the front wing – that is, by a means other than by connection of a plurality of engaging elements to inner attachment surfaces. Accordingly, claim 14 cannot and does not read on the diaper of Sayama. As for Ames, Ames discloses a diaper having multiple fastening systems adapted to connect the front and back waist regions. Col. 2, line 34 to col. 3, line 10. One fastening system allows the front and back waist regions to be connected by engaging the front waist region fastening members 80 with the rear waist closure member 78. See col. 22, lines 36-61; Fig. 4. Another fastening system allows the front and back waist regions to be connected by engaging the first closure member 82 and the second belt flap closure member 76 with the third closure member 82. See col. 22, line 62 to col. 23, line 13; Fig. 5. Accordingly, because Ames discloses a diaper having multiple means of connecting the front waist region to the back waist region, Ames cannot and does not disclose an article not refastenably connectable other than by the refastenable connection of a plurality of engaging elements to inner attachment surfaces. Indeed, both Sayama and Ames teach away from such an approach. Consequently, claims 7, 14, and 24 are patentable over both Sayama and Ames, alone or in combination, for this additional reason.

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Accordingly, claims 1, 9, and 19, and all claims which depend therefrom, are patentable over the cited references. Applicants explicitly reserve the right to identify additional errors in the Office Action and advance further reasons for patentability should the present response not result in withdrawal of the rejection.

B. Rejection Of Claims 8, 17, 26, and 30 Under 35 U.S.C. § 103 (a)

Claims 8, 17, 26, and 30 stand rejected as being unpatentable over Sayama in view of Ames and further in view of U.S. Patent No. 5,087,253 issued February 11, 1992 to Cooper. Applicants traverse the rejection.

Claim 8 depends from claim 1 and further recites that the absorbent article comprises a pair of fastening components disposed in the second waist region on the outer surface, the fastening components comprising hook-type fasteners, each fastening component having a length dimension that is generally parallel to the longitudinal axis, a width dimension, and a length-to-width ratio of about 5 or greater. Claims 17 and 30 are similar to claim 8 but depend from claims 9 and 19, respectively.

Claim 26 depends from claim 19 and further recites that the refastenable engagement of the attachment panels to the at least one fastening component forms refastenable seams that cover about 80 to about 98 percent of the distance between the waist opening and each leg opening.

First, Applicants believe that claims 8, 17, 26, and 30 are patentable over Sayama/Ames for the same reasons set forth above with respect to claims 1, 9, and 19. The addition of the third reference, Cooper, does not cure any of the deficiencies noted above.

The Examiner concedes that the two-way Sayama/Ames combination "does not provide fastening components with a length-to-width ratio of 5 or greater." Office Action, page 8. To address this deficiency, the Examiner adds Cooper. As motivation to add Cooper to this combination, the Examiner says only the following:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the diaper of Sayama/Ames with fasteners such as disclosed by Cooper in order to sufficiently hold the diaper on the user, which Cooper teaches is desired.

Id. Applicants assert that this is a wholly inadequate basis for a motivation to add Cooper to Sayama/Ames. The objective of having a fastening system that will "sufficiently hold the diaper on the user" can be said about virtually every absorbent article fastening system designed over the past several decades. Under the Examiner's approach, this extremely general objective could form the

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basis to add virtually any reference that disclosed virtually any fastening system to an obviousness combination. Applicants respectfully assert that the Examiner has merely searched for a reference having these particular claim elements (underlined above) and added it to the combination. The law requires more.

The Supreme Court recently spoke on the law of obviousness. Although the Court rejected a rigid approach to the use of TSM test, the Court recognized the continued utility of the test. Further, the Court stated that it is still necessary to identify a specific reason for combining references:

Often, it will be necessary ... to look to interrelated teachings of multiple patents; the effects known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis **should be made explicit**.

KSR Int'l Co. v. Teleflex, Inc., No 04-1350 at 4 (U.S. Apr. 30, 2007) (emphasis added). Therefore, in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed. Memorandum from Margaret A. Focarino, Deputy Commissioner for Patent Operations to Technology Center Directors, May 3, 2007.

The reason the Examiner articulates as an alleged motivation to add Cooper to the combination is merely a recitation of what she believes to be the benefits offered by the diaper of Cooper. Articulating a generic function of Cooper – to “sufficiently hold the diaper on the user” – is a bland and meaningless basis for a motivation to combine. Neither Sayama nor Ames discusses any deficiencies presented by each of its fastening systems. Furthermore, Cooper is directed primarily to a universal combination diaper/training pant suitable for wearers of various sizes, and does not disclose any particular or special benefit offered by its fasteners. In sum, the Examiner has identified no meaningful reason or motivation, either in the references themselves or in the mind of one of skill in the art generally, to make a three-way combination among Sayama, Ames, and Cooper.

Accordingly, claims 8, 17, 26, and 30 are believed to be patentable over Sayama, Ames, and Cooper.

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C. Conclusion

The application now contains claims 1, 4, 7-9, 11, 14, 15, 17-19, 21, and 24-34 which are believed to be in condition for allowance in view of the foregoing remarks.

Please charge any prosecutorial fees which are due to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875.

The undersigned may be reached at: (920) 721-7844.

Respectfully submitted,

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CERTIFICATE OF TRANSMISSION

I, Mary L. Marchant, hereby certify that on September 18, 2007 this document is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (571) 273-8300.

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